

AMENDMENT
U.S. Appln. No. 10/070,556

REMARKS

Upon entry of the claim amendment, Claims 1-98 will be all the claims pending in the application.

New Claim 98 is supported by the description at page 70, lines 14-21.

Applicants affirm their election of Group I, Claims 1-16. Furthermore, Applicants respectfully submit that new Claim 98, which depends from Claim 1, should be included within Group I.

Applicants have amended the abstract herein. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the objection to the abstract.

At Section No. 4, page 3, of the Action, Claims 1-16 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In particular, the Examiner asserts that the following phrase in Method 1 (page 184) is not clear: "... an enzyme capable of asymmetrically hydrolyzing an ester or a liquid culture medium of a microorganism, cells of this microorganism or processed cells of this microorganism" The Examiner queries "What enzymes or liquid culture medium of microorganisms are covered and what are not?"

Applicants respectfully traverse.

Breadth of a claim is not to be equated with indefiniteness. In re Miller, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if the applicant has not otherwise indicated that he intends the invention to be of a scope different from that defined in the claims, then the claims comply with the second paragraph of §112.

In the present case, the scope of the claimed subject matter is clear on its face. The plain meaning of the terms in Claim 1 requires that any enzyme, liquid culture medium of a microorganism, cells of this microorganism or processed cells of this microorganism that is capable of asymmetrically hydrolyzing an ester be included within the scope of the present claims.

Furthermore, Applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims. On the contrary, the present

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specification specifically indicates at page 70, lines 12-14, that "[t]he enzyme, etc. usable in this reaction is not particularly restricted, so long as it is capable of asymmetrically hydrolyzing an ester." As is clearly understood from page 70, lines 6-21, the term "etc" refers to "a liquid culture medium of a microorganism, cells of this microorganism or processed cells of this microorganism."

Therefore, per the decision in Miller, the present claims, including Claim 1, are clear and definite and comply with the second paragraph of §112.

For the foregoing reasons, Applicants respectfully request that the Examiner reconsider and withdraw this §112, second paragraph, rejection of Claims 1-16.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



L. Raúl Tamayo
Registration No. 47,125

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

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